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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,971 01/15/99 VALENTE

G 30966.13USWU

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EXAMINER

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 12/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/214,971

Applicant(s)

Valente

Examiner

Alicia Chevalier

Group Art Unit

1772



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 4 contain the trademarks/trade names Bontex®, Texon®, Salpa®, Goretex®, Simpatex®, and Surlyn®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademarks or trade names cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe cellulosic material, a mixture of leather regenerated materials or derivatives thereof, a perspiring material, and polyethylene film and, accordingly, the identification/description is indefinite.

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The terms "e.g." and "such as" in claims 1 and 4 is a relative term which renders the claims indefinite. These types of terms are indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

The phrase "a mixture of leather regenerated materials or derivatives thereof" in claim 1 is unclear and renders the claim vague and indefinite. It is uncertain what "regenerated materials" means. Does applicant mean synthetic leather?

The phrase "coagulated material" in claim 1 is unclear and renders the claim vague and indefinite. It is uncertain what types of coagulated materials applicant wishes to claim. The term "coagulated" is very broad and encompasses almost any material.

The phrase "perspiring material" in claim 1 is unclear and renders the claim vague and indefinite. It is uncertain what type of perspiring materials applicant wishes to claim. The term "perspiring" is very broad and encompasses almost any material.

The term "leather-like" in claim 2 is unclear and renders the claim vague and indefinite. The claim is indefinite because it does not clearly state what exact scent of leather the composite material should possess. The use of the word **like**, in particular, is unclear.

The phrase "supporting material is spread with a leather-like scent" in claim 2 is unclear and renders the claim vague and indefinite. It is uncertain what is meant by the word "spread." Is the supporting material impregnated with some kind of aromatic chemical that has a leather scent to it.

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Claim 4 provides for the use of "a composite material", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The following is from the MPEP §2173.05(q) "Use Claims":

Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon" was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1086).

Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. For the purpose of the following rejections under 35 U.S.C. 102 and 35 U.S.C. 103 little weight is given to process limitations. Determination of patentability of product-by process claims is based on the product itself and does not depend on the product's method of production.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by GB1514224. GB1514224 teaches a composite material that simulates leather and may be used in virtually all areas where real leather can be used, for example, in upholstery, apparel, handbags, luggage and footwear (page 1, lines 23-27). The composite material comprising a fabric layer (supporting material), a crushed foam layer, and a surface finish laminate layer (covering surface layer) (page 1, lines 28-36). A typical textile fabric to be used is cotton (cellulosic material) (page 1, lines 45-46). The surface finish laminate can be embossed (page 5, line 36) and made of polyethylene (page 5, line 22). The film can be made breathable by mechanically puncturing (perforations) the film (page 5, lines 56-58).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB1514224 in view of Hara (JP404130172A). GB1514224 teaches all the limitations of the claimed invention as disclosed above except that the composite material has a leather scent. Hara teaches a leather coat film with a leather perfume layer (Derwent abstract). It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of GB1514224 because it would increase to illusion that the composite material of GB1514224 was real leather.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac



December 17, 1999



Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700